

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-45 are pending in the application, with 1, 13, 16, 28, 31, 36, and 41 being the independent claims. Claims 13-15, 31, 41, 42, and 45 are amended. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 101

Paragraph 1 of the Notice states that the "amendment to the claims filed on 12/22/2004 does not fully comply with the requirements of the prior Office action (filed 8/25/2004) because the amendments to the claims 13-15, 31-35, 41 & 43-45 do not correct 35 USC 101 (not within the technology arts) rejections as required by the prior Office action." Applicants respectfully disagree, but have further amended claims 13, 31, and 41 to expedite prosecution of the Application.

As stated in the M.P.E.P., "[f]or such subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10). See also *Alappat* 33 F.3d at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring) ("unpatentability of the

principle does not defeat patentability of its practical applications") (citing *O'Reilly v. Morse*, 56 U.S. (15 How.) at 114-19). A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. See *AT&T*, 172 F.3d at 1358, 50 USPQ2d at 1452" (M.P.E.P. sec. 2106 IV.(B)2.(b)).

As shown above, independent claims 13, 31, and 41 have been amended to recite methods that produce a concrete, tangible and useful result, and thus are limited to a practical application in the technical arts. The preamble of claims 13, 31, and 41 have been amended to recite "a computer implemented method." Claim 13 (shown in part) has been amended to recite:

(3) selecting one or more advertisements based on one or more of the user profile, the location of the mobile device, and the time of day to generate a group of advertisements; and

(4) transmitting the generated group of advertisements to the mobile device to present the generated group of advertisements to the user for viewing on the mobile device and to enable the user of the mobile device to interact with the generated group of advertisements on the mobile device.

Claim 31 (shown in part) has been amended to recite:

(2) displaying the advertisements in a rotational fashion on the mobile device to provide access to the plurality of advertisements to a user of the mobile device;

(3) enabling the user to interact with a selected advertisement of the rotationally displayed advertisements at the mobile device to provide additional information regarding the selected advertisement to the user.

Claim 41 (shown in part) as amended recites:

- (2) determining whether the trigger is of interest to a user of the mobile device;
- (3) selecting advertisements based on the trigger; and
- (4) enabling the display of the selected advertisements on said mobile device and the interaction of a user with the displayed advertisements to provide additional information regarding the displayed advertisements to the user.

In each case, the claimed invention enables advertisements to be presented to users of mobile devices. There is no doubt that marketing and advertising are important components of society. Thus, technology that enables marketing and/or advertising unquestionably produce "a concrete, tangible and useful result." Therefore, Applicants respectfully assert that independent claims 13, 31, and 41 are limited to a practical application in the technical arts, and are therefore patentable under 35 U.S.C. § 101. Claims 14, 15, 32-25, and 43-45, which depend therefrom, are also patentable under 35 U.S.C. § 101 for at least these reasons, and further in view of their own features.

Accordingly, Applicants respectfully request that the rejection of claims 13-15, 31-35, 41, and 43-45 be reconsidered and withdrawn.

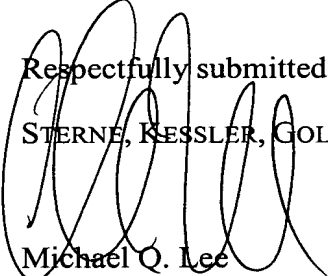
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Notice and previous Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.


Michael Q. Lee
Attorney for Applicants
Registration No. 35,239

Date: April 22, 2004

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600